

**REMARKS**

This Amendment is filed in connection with a Request for Continued Examination and a Request for a 2-Month Extension of Time in response to the Final Office Action mailed Nov. 1, 2007. The Applicant respectfully requests favorable action in light of the below discussion. All objections and rejections are respectfully traversed.

Claims 1-2, 4-17, and 19-33 are now pending in the case.

Claims 1-2, 4-17, and 19-33 have been amended to better claim the invention

Claims 3 and 18 have been cancelled

No new claims have been added.

***Claim Rejections - 35 U.S.C. §102***

At paragraphs 3-4 of the Final Office Action, claims 1, 2, 7, 8, 12, 13, 15, 16, 20, 21, 25-26, 29-31 were rejected under 35 U.S.C. §102(e) over Chen, U.S. Patent No. 6,553,423 (hereinafter Chen).

The Applicant's claim 1, representative in part of the other rejected claims, sets forth:

1. (CURRENTLY AMENDED) A method for allowing a router to efficiently determine a time-to-live (TTL) configuration of a peer router in a computer network, the method comprising the steps of:

***automatically determining which TTL mode of operation the peer router supports*** by sending an initial Border Gateway Protocol (BGP) message from the router to the peer router, ***the initial BGP message including a first predetermined value of a TTL parameter;***

if the router receives a positive acknowledgement of the initial BGP message from the peer router, ***determining that the peer router supports exchanges of messages using a new TTL mode of operation;*** and

if the router receives a negative acknowledgement of the initial BGP message from the peer router, ***deciding that the peer router does not support the new TTL mode of operation, and switching to an old TTL mode of operation by resending the initial BGP message with a second predetermined value of the TTL parameter.***

Chen discloses a “capabilities optional parameter” that may be used in a BGP Open message (Fig. 7) or in a BGP capabilities message (Fig. 8). The “capabilities optional parameter 700 comprises a 1-byte capability code field 702, a 1-byte capability length field 704, and a variable length capability value field 706.” *See* col. 5, lines 29-33. “[T]he capabilities optional parameter is used by a BGP speaker to convey to its BGP peer a list of capabilities supported by the speaker.” *See* col. 5, lines 39-41. If the capabilities of the speaker change, the speaker may send another message to “replace a previously announced capability.” *See* col. 6, lines 51-52.

The Applicant respectfully urges that Chen does not teach or suggest the Applicant’s claimed *“automatically determining which TTL mode of operation the peer router supports by sending an initial Border Gateway Protocol (BGP) message from the router to the peer router, the initial BGP message including a first predetermined value of a TTL parameter”* and *“determining that the peer router supports exchanges of messages using a new TTL mode of operation”* or *“deciding that the peer router does not support the new TTL mode of operation, and switching to an old TTL mode of operation by resending the initial BGP message with a second predetermined value of the TTL parameter.”*

The Applicant’s amended claims recite determining a TTL mode of operation by sending a message including a first predetermined value of a TTL parameter and making certain determinations from acknowledgements received in response thereto. There appears to be agreement that Chen is silent concerning time-to-live (TTL) modes of operation, TTL parameters, and the like. Indeed, at paragraph 6 of the Final Office Action, the Examiner comments “Chen was silent about new capability parameter being a time-to-live (TTL) parameter...” and turns to a second reference in relation to TTL related features. Accordingly, the Applicant believes there should be agreement that Chen alone does not teach these aspects of the claims.

As such, the Applicant respectfully urges that Chen is legally insufficient to anticipate the present claims under 35 U.S.C. §102 because of the absence of the Applicant’s claimed novel *“automatically determining which TTL mode of operation the peer*

*router supports by sending an initial Border Gateway Protocol (BGP) message from the router to the peer router, the initial BGP message including a first predetermined value of a TTL parameter” and “determining that the peer router supports exchanges of messages using a new TTL mode of operation” or “deciding that the peer router does not support the new TTL mode of operation, and switching to an old TTL mode of operation by resending the initial BGP message with a second predetermined value of the TTL parameter.”*

***Claim Rejections - 35 U.S.C. §103***

At paragraphs 6-7 of the Office Action, claims 3-6, 9-11, 14, 18, 19 and 22-24 were rejected under 35 U.S.C. §103(a) over Chen in view an Internet Draft by Gill et al., title “The BGP TLL Security Hack (BTSH)” (hereinafter “Gill”).

**I. Chen is Disqualified as Prior Art under 35 U.S.C. §103(a) by Operation of 35 U.S.C. §103(c)**

The Applicant respectfully urges that Chen may not be used as prior art in a 35 U.S.C. §103(a) rejection by operation of 35 U.S.C. §103(c).

Chen and the subject matter of the present application were both owned by Cisco Technology, Inc. at the time that the present invention was made.

The statute 35 U.S.C. 103(c) states (emphasis added):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability** under this section where the subject matter and claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation to the same person.

The subject matter of the present application was developed by inventors having an obligation to assign their rights to Cisco Technology, Inc. The present application was assigned to Cisco Technologies, Inc. by an assignment recorded at Reel/Frame 014530/0043 on Sept 18, 2003, the date the application was filed

Chen was previously assigned to Cisco Technology, Inc. by an assignment recorded at Reel/Frame 010002/0505 on May 27, 1999.

35 U.S.C. §103(c) is satisfied since Chen does not qualify as §102(a), (b), (c) or (d) prior art.

35 U.S.C. §102(a) states a person is entitled to a patent unless “the invention... was patented or described in a printed publication.... before the invention thereof by the applicant.” Chen was first published on Apr. 22<sup>nd</sup>, 2003 when it issued as a patent. The Applicant files herewith a Declaration Under 35 C.F.R. 1.131 establishing conception of the invention prior to Apr. 22<sup>nd</sup>, 2003 and diligence until reduction to practice. As a result of such Declaration Under 35 C.F.R. 1.131, Chen to not qualify as prior art under §102(a).

35 U.S.C. §102(b) states a person is entitled to a patent unless “the invention was patented or described in a printed publication ... more than one year prior to the date of the application for patent in the United States.” Chen does not qualify as prior art under §102(b) because Chen published and issued on Apr. 22<sup>nd</sup>, 2003, only approximately 5 months before the present application’s filing date of Sept. 18<sup>th</sup>, 2003.

35 U.S.C. §102(c) states a person is entitled to a patent unless “he has abandoned the invention.” The Applicant has not abandoned the present invention.

35 U.S.C. §102(d) states a person is entitled to a patent unless “the invention was first patented or caused to be patented ... in a foreign country prior to the date the application for patent in this country on an application for patent ... filed more than twelve months before the filing of the application in the United States.” The present invention was not patented in a foreign country before filing in the United States.

Accordingly, the Applicant respectfully urges that Chen may only potentially qualify as prior art only under 35 U.S.C. §102(e), §102(f), or §102(g). Therefore, all the requirements of 35 U.S.C §103(c) are satisfied, and Chen is legally precluded from serving as a reference under 35 U.S.C. §103(a) by operation of 35 U.S.C §103(c).

## **II. Gill Alone Do Not Disclose Evert Element of What is Claimed**

The Applicant respectfully urges that Gill does not disclose all the elements of the Applicant’s claims. Accordingly, absent Chen which is precluded from use as prior art

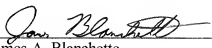
under 35 U.S.C. §103(a) by operation of 35 U.S.C. §103(c), rejection of the claims is believed to be inappropriate. Accordingly, the Applicant respectfully requests issue of a Notice of Allowance.

Should the Examiner believe telephonic contact would be helpful in the disposition of this Application, the Examiner is encouraged to call the undersigned attorney at (617) 951-2500.

In summary, all the independent claims are believed to be in condition for allowance and therefore all dependent claims that depend there from are believed to be in condition for allowance. The Applicant respectfully solicits favorable action.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

  
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